

REMARKS

The Specification has been amended for clarification purposes only, and does not present new matter. No amendments, additions, or cancellations have been made to the present claims. Therefore, claims 1, 3-8, 10-19, 21, and 22 are currently pending in the case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Double Patenting Rejection

Claims 1, 3-8, 10-19 and 21-22 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,603,839 to Smith, et al. (hereinafter "Smith"). In response thereto, a Terminal Disclaimer is submitted in a separate paper to obviate the double patenting rejection in accordance with 37 C.F.R. § 1.321(c). The terminal disclaimer is believed to be sufficient to overcome any assertion of judicially created obviousness-type double patenting between the present claims and claims 1-23 of Smith.

Section 103 Rejections

Claims 1, 3-8, and 10-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,373,940 to Shaffer et al (hereinafter referred to as "Shaffer") in view of U.S. Patent No. 5,903,632 to Brandon (hereinafter referred to as "Brandon"). To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). None of the cited art teaches or suggests all limitations of claims 1, 3-8 and 10-19, some distinctive limitations of which are set forth in more detail below.

None of the cited art teaches or suggests an electronic communications device having a storage medium with program instructions executable for receiving an electronic notification of a change to a directory entry stored within the electronic communications device, wherein the electronic notification is associated with an identifier, category heading and an altered value. Amended claim 1 recites in part:

An electronic communications device comprising: a processor; and a storage medium comprising program instructions executable by the processor for: receiving an electronic notification of a change to a directory entry stored within the electronic communications device, wherein the electronic notification is associated with an identifier, a category heading, and an altered value...

The presently claimed case provides a system and method for updating directory entries within an electronic communication device upon receipt of an electronic notification of a change to one or more directory entries. Electronic communication devices may include, but are not limited to telephones, facsimile machines and electronic organizers. The presently claimed system and method allows an existing directory entry (i.e., an entry stored within the directory of the electronic communications device) to be automatically updated upon receipt of an electronic notification of a change to a directory entry and an acceptance command from a user of the device. As recited above, the electronic notification includes an identifier, a category heading, and an altered value. (See, e.g., Abstract and present claims).

Shaffer discloses a system for transmitting address changes between source communication devices and destination communication devices. Shaffer, however, fails to teach or suggest an electronic communications device having a storage medium with program instructions executable for receiving an electronic notification of a change to a directory entry stored within the electronic communications device, wherein the electronic notification is associated with an identifier, category heading and an altered value, as recited in present claim 1.

On page 4 of the Office Action, the Examiner admits that "Shaffer fails to clearly teach a storage medium... comprising program instruction[s] executable by the processor... [for receiving an] electronic notification... associated with an identifier, a category, and an altered value." Therefore, the Examiner admits that Shaffer does not teach or suggest all limitations of present claim 1. However, the Examiner suggests that "Brandon teaches such features (see col.3, ln.35-39, col.4, ln.35-67) for a purpose of organizing the information in [a] telephone directory." (Office Action, page 4). The Examiner further suggests that it would have been obvious to incorporate the "features" of Brandon into the "electronic notification messages" of Shaffer "in order to save time and convenient for searching and updating the directory." (Office Action, page 4). The Applicant respectfully disagrees, for at least the reasons set forth in more detail below.

Brandon discloses a "telephone directory system for identifying and displaying directory information related to incoming and outgoing telephone calls." (Brandon, column 1, lines 6-10). More specifically, Brandon discloses an electronic communications device (e.g., telephone 1, FIG. 1) with various storage mediums for storing directory information (e.g., mass data storage device 36 and flash RAM 39, FIG. 2) and for storing "the program code used by the CPU 13 to perform all of the functions of the automated telephone directory" (See, e.g., Brandon, column 3, lines 35-40, and ROM 39 of FIG. 2). As pointed out by the Examiner, Brandon also discloses how the directory entries may be displayed on a display screen (3, FIGS. 4-7) for purposes of searching through the directory entries (See, e.g., Brandon, column 4, lines 35-67).

However, Brandon does NOT disclose a method for updating existing directory entries, or even the possibility that existing directory entries could be changed or updated. Therefore, Brandon simply cannot teach or suggest "receiving an electronic notification of a change to a directory entry stored within the electronic communications device", as recited in present claim 1. Since Brandon fails to mention that directory entries can be changed or updated, the teachings of Brandon cannot be relied upon (as suggested by the Examiner) to teach or suggest the presently claimed electronic notification message, which is "associated with an identifier, a category heading, and an altered value." As a consequence, Brandon fails to teach or suggest all limitations of present claim 1.

As noted above, Shaffer and Brandon each fail to provide teaching or suggestion for the above-mentioned limitation of present claim 1. Therefore, even if the "features" of Brandon were incorporated into the "electronic notification messages" of Shaffer, the combined teachings of the cited art would still fail to disclose all limitations of present claim 1.

In addition, Applicants assert that the cited art cannot be modified to teach or suggest the aforementioned claim limitation, since neither Shaffer nor Brandon suggest a desirability for doing so. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination [or modification]. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. There is simply no motivation within the cited art to modify the teachings of Shaffer and/or Brandon to include the aforementioned claim limitation.

Since none of the cited art teaches, suggests, or provides motivation for the aforementioned claim limitation, the cited art cannot be combined or modified to do so. As stated above, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP 2143.01.

For at least the reasons set forth above, none of the cited art teaches, suggests, or provides motivation for all limitations of independent claim 1. Therefore, claim 1 and claims dependent therefrom, are considered to be patentably distinct over the cited art. Removal of this rejection is hereby respectfully requested.

CONCLUSION

In the Conclusion section of the Office Action, the Examiner noted several patents that were not relied upon in the Office Action, but were presented for the Applicant's consideration. These patents do not appear to be included within any IDS or PTO-892 form filed during the prosecution of this application. Applicants respectfully request that the Examiner formally enter these patents on a PTO-892 form, even though the prior art made of record but not relied upon is not considered pertinent to the presently claimed case.

This response constitutes a complete response to all issues raised in the Office Action mailed July 9, 2004. In view of the remarks traversing the rejections, Applicants assert that pending claims 1, 3-8, 10-19, 21, and 22 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 50-3268/5468-05000.

Respectfully submitted,



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